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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,492	02/27/2002	David Farcot	P21987	8439
7055	7590	10/16/2003	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			BOTTORFF, CHRISTOPHER	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,492

Applicant(s)

FARCOT ET AL.

Examiner

Christopher Bottorff

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-19 and 21-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 9, 10, 13, 14, 16-18, 23-25, 28-30 and 35-42 is/are rejected.
- 7) ☒ Claim(s) 5, 8, 11, 15, 19, 21, 22, 26, 27 and 31-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15. 6) ☐ Other:

DETAILED ACTION

The amendment filed August 18, 2003 has been entered. Claims 33-42 are added. Claims 1-11, 13-19, and 21-42 are pending.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on August 18, 2003 was considered by the examiner.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the base with at least two elongated holes extending through a thickness of the base must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claims 13, 38, and 40 each define the base as having elongated holes extending through the thickness of the base. Such a base may include a disk disposed in a circular opening in the base such that the holes are located on the disk, or the holes may be provided directly in the base without the use of a disk. Claims 14, 39, and 42 define the embodiment including the disk, and this embodiment is depicted in figures 1-6. Paragraph 0071 of the specification discloses the embodiment in which the disk is not used, however, this embodiment is not depicted.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 1 is objected to because of the following informalities: line 6 states "elongated holes extending extend through a thickness of the disk." The use of the term "extend" is in error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 35-38 and 40 indicate that the single plate is the only plate of the assembly having the predetermined size and shape. However, the disclosure does not distinguish the single plate from a second plate based upon size and shape. That is, the second plate that does not have the predetermined size and shape is not supported

by the original specification. Thus, the limitations that attempt to distinguish the single plate from another plate based on size and shape represent new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 38, 39, and 41 are rejected under 35 U.S.C. 112, second and sixth paragraphs, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 defines means for retaining the screws on the plate and for connecting the plate to the disk when the base is not affixed to the sports apparatus. Claims 38 and 41 define the screws as having means for retaining the plate connected to the base when the screws are not screwed into the sports apparatus. However, the structure comprising the means is not clear under 35 USC 112, paragraph six, as invoked by Applicants on page 12 of the amendment filed April 17, 2003.

Paragraphs 0039-0044 of the specification disclose a means for retaining the screws on the plate including the diameter of the threaded portion of the screw being substantially equal to the diameter of the corresponding hole in the plate. However, this means would only connect the plate to the disk when the base is not affixed to the sports apparatus if the plate is disposed beneath the base or disk. If the plate were disposed above the base or disk, this means would only retain the screws on the plate and would not connect the plate to the disk. Thus, the claims are unclear as to whether the means includes the screw diameter at the threaded portion relative to the diameter

of the hole in the plate alone or the screw diameter at the threaded portion relative to the diameter of the hole in the plate in combination with the location of the plate being below the base or disk.

In section B. 3. of the remarks to the amendment filed August 18, 2003, Applicants indicate that the limitations in which the plate is disposed in the lower surface of the base or disk are only present in dependent claims. Since the means plus function limitation in question appears in independent claims 6 and 38, for the purposes of examination the means have been interpreted as being the screw diameter at the threaded portion relative to the diameter of the hole in the plate alone without locating the plate below the base or disk. This means would connect the plate to the disk when the base is not affixed to the sports apparatus to the same extent as the claimed means. Applicants are invited to further clarify the structure of the means capable of performing the claimed functions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 7, 9, 10, 13, 14, 16-18, 23-25, 28-30, and 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller et al. US 5,909,893 in view of Vitali et al. US 5,380,031.

Keller et al. discloses an assembly for retaining a boot on a sports apparatus. See figure 3; column 2, lines 44-50; and column 4, lines 6-29. The assembly has a disk 1 that retains a base 9 and is supported above a through opening of the base, wherein the disk includes four elongated holes 10 that extend through a thickness of the disk, are parallel to one another, are aligned in pairs, are elongated in the same direction, and are across from one another. Also, two generally rectangular plates 12 that are parallel to the disk and are housed in a cavity 11 of the disk, wherein the cavity has a generally parallelepipedic contour. Each plate includes two holes 13 extending through a thickness of the plate and each plate slides along the length of the elongated holes. At least two screws 8 extend through the elongated holes of the disk, the holes of each plate, and into an upper surface of the sports apparatus.

Keller et al does not disclose a retaining means, wherein the means is a plate hole with a diameter substantially equal to the diameter of the threaded portion of the screw, and the screw head and threaded portion interact with the plate hole to retain the screw on the plate as discussed in paragraphs 0039 – 0043. Keller et al. does not disclose that the plate is made of plastic or metal. Keller et al. does not disclose the precise thickness of the plate, although it appears to be between 0.1 mm and 1.0 mm based upon the proportions depicted in Figure 3. In addition, the plate is not square with four holes spread to the four corners or three holes arranged at vertices of a triangle, and the size and shape of one plate is not different from the size and shape of the other plate.

Vitali et al. teaches the old and well known retaining means for retaining screws on a plate, and teaches plate materials and thickness. See Figures 1-6 and column 3, lines 4-16, 23-29, 39-52, and 63-67. The retaining means includes a plate hole 7 with a diameter 9 substantially equal to the diameter of the threaded portion of a screw 1. The screw is sized, relative to the plate hole, to be forcibly screwed through the plate hole, thereby allowing the screw head and threaded portion to interact with the plate hole to retain the screw on the plate when assembled. Also, the plate may be made of either plastic or metal and has a thickness of between 0.1 mm and 1.0 mm. From the teachings of Vitali et al., providing the assembly of Keller et al. with a retaining means for retaining the screws on the plate would have been obvious to one of ordinary skill in the art at the time the invention was made. This would aid in assembly by precisely providing a desired screw length protruding beneath the lower surface of the binding. Also, from the teachings of Vitali et al., providing the assembly of Keller et al. with a plate made of plastic or metal and of the claimed thickness would have been obvious to one of ordinary skill in the art at the time the invention was made. This would ensure that the plate has sufficient strength.

In regard to the generally square shape of the plate, providing the plates of Keller et al. in a generally square shape, rather than two rectangles, represents an obvious design choice that was within the purview of one of ordinary skill in the art at the time the invention was made. Also, providing the plates with different sizes and shapes represents an obvious design choice that was within the purview of one of ordinary skill in the art at the time the invention was made. The court has held that the shape and

size of a component is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant. *In re Dailey*, 149 USPQ 47 (CCPA 1966) and *Gardner V. TEC Systems, Inc.*, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 225 USPQ 232 (1984). Moreover, in paragraph 0037 on page 7 of the specification Applicants state that the shape of the plate is not a critical feature.

Allowable Subject Matter

Claims 5, 11, 19, 21, 22, 26, 27, 31, and 32 are objected to as being dependent upon a rejected base claim as noted in the previous office action, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims define the plate hole arrangement as being four holes positioned at four corners of a square or three holes arranged at vertices of a triangle. The prior art does not teach such a plate hole arrangement in combination with the further limitations of the claims.

Also, claims 8, 15, 33, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims define the plate as being located beneath the disk or, more particularly, as being housed on a cavity recessed in the lower surface of the disk. The prior art does not teach this plate location in combination with the further limitations of the claims.

Response to Arguments

Applicant's arguments filed August 18, 2003 have been fully considered but they are not persuasive, except for argument directed to the plate being located below the base or disk. Although a plate located below the base or disk is not taught in combination with the further limitations of the claims, a plate located on the lower portion of the base or disk is taught by Keller et al. The lower portion of the base or disk is not necessarily the lower surface of the base or disk. The lower surface of cavity 11 represents a lower portion of the disk within the scope of the claims.

In regard to the claimed "single disk," the ordinary meaning of the word "single" is not limited to the narrow definition cited by Applicants. *Webster's II New Riverside University Dictionary*, Houghton Mifflin Co., Boston, Mass., 1994, also defines "single" as "separate from others" and "distinct." This ordinary meaning does not imply one and only one and is given to the word "single" in the examiner's interpretation of the claims.

Furthermore, Applicants' intent in the meaning of the word "single" is unclear. In the remarks to the August 18, 2003 amendment, Applicants suggest that "single" is to be construed under a narrow definition that allows one and only one plate to the exclusion of any other number of plates, such as the two plates utilized by Keller et al. However, the claims suggest that "single" should be construed more broadly such that additional plates are not excluded. In claims 1, 7, and 13, "single" is qualified by the broad transitional phrase "comprising" rather than a narrow phrase such as "consisting of." This suggests that "single" is not intended to exclude the presence of additional plates. Also, dependent claims 35, 36, and 37 distinguish the single plate from

additional plates based upon size and shape. This claim differentiation suggests that “single” is not intended to exclude the presence of additional plates. In the event that Applicants intend to limit the claims to one and only one plate, the claims should be amended to be consistent with that intent.

In regard to claims 7 and 13, the claims do not require all of the screws of the assembly to pass through one and only one plate, as suggested by Applicants. Rather, claims 7 and 13 only require at least two screws to extend through the respective two holes of the plate. At least two screws 8 of Keller et al. do extend through the holes of plate 10, thereby satisfying the limitations of the claims.

In regard to Vitali et al., there is no need for Vitali et al. to teach a slidable plate or movable screws since this structure is already taught by Keller et al. Vitali et al. is relied upon simply to teach the common retaining means structure in a retaining assembly of a sports apparatus. Also, the objective of Vitali et al. is broader than the objective identified by Applicants, and the means that achieves this objective would be a beneficial addition to the assembly of Keller et al. based upon the advantages identified by Vitali et al. Note the objectives identified in column 2, lines 11-29. Since the means of Vitali et al. is compatible with different types of bases as stated on lines 22-23 of column 2, the means would be compatible with the assembly of Keller et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

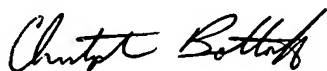
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shannan et al., Schweizer, and Trimble disclose assemblies for retaining boots on sports devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

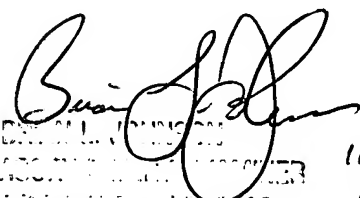
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher Bottorff



SUSAN JOHNSON
SUPERVISOR, ART UNIT 3618
TECHNOLOGY CENTER 3000

10/15/03